UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

1C

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/002,129	10/31/2001	Jay H. Connelly	42390P13399	2646

8791 7590 02/06/2007

BLAKELY SOKOLOFF TAYLOR & ZAFMAN
12400 WILSHIRE BOULEVARD
SEVENTH FLOOR
LOS ANGELES, CA 90025-1030

EXAMINER	
RUHL, DENNIS WILLIAM	
ART UNIT	**PAPER NUMBER**
3629	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/06/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/002,129	CONNELLY, JAY H.	
	Examiner	Art Unit	
	Dennis Ruhl	3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *03 January 2007*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-49* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-49* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

Applicant's amendment of 1/3/07 has been entered. The examiner will address applicant's remarks at the end of this office action.

1. The following is a quotation of 37 CFR 1.71(a)-(c):

> (a) The specification must include a written description of the invention or discovery and of the manner and process of making and using the same, and is required to be in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which the invention or discovery appertains, or with which it is most nearly connected, to make and use the same.
>
> (b) The specification must set forth the precise invention for which a patent is solicited, in such manner as to distinguish it from other inventions and from what is old. It must describe completely a specific embodiment of the process, machine, manufacture, composition of matter or improvement invented, and must explain the mode of operation or principle whenever applicable. The best mode contemplated by the inventor of carrying out his invention must be set forth.
>
> (c) In the case of an improvement, the specification must particularly point out the part or parts of the process, machine, manufacture, or composition of matter to which the improvement relates, and the description should be confined to the specific improvement and to such parts as necessarily cooperate with it or as may be necessary to a complete understanding or description of it.

The specification is objected to under 37 CFR 1.71 because it fails to provide an adequate written description of the invention so that one of skill in the art can make and use the claimed invention. Applicant is referred to the 112,1st rejection for the specifics and a detailed explanation from the examiner.

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-49 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to

which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Applicant has amended each independent claim to include the language of "*determining whether the reference magnitude is relevant by comparing the reference magnitude to a total number of products downloaded by the consumer*". On page 16 of the instant specification it is disclosed that the reference magnitude is "the raw number of times a key/value pair was present in a product for which a consumer rating was determined by the CPS". The only disclosure relating to a comparison of the reference magnitude to a total number of downloaded products is found on lines 5-7 of page 17 (para. 44). Based on the disclosure in the specification, one of skill in the art would not know how to go about and determine if the reference magnitude is relevant by comparing the reference magnitude with the total number of products downloaded as claimed. The specification does not teach to one of skill in the art how to go about determining if the reference magnitude is relevant or not. Initially, the examiner does not see how the total number of downloaded products even relates to whether or not the reference magnitude is relevant. What does the number of downloads have to do with the reference magnitude? One of skill in the art can clearly compare two numbers, but one of skill in the art would not understand how the comparison of a reference magnitude to a total number of downloads can result in a determination of whether or not the reference magnitude is relevant. The total number of downloads has nothing to do with the reference magnitude being relevant. This is like comparing apples to oranges, the pieces of data being compared have nothing to do with each other so their

comparison is of no value to a person of skill in the art. One of skill in the art would not understand how the claimed step of comparing these two numbers could possibly allow a determination of relevancy to even occur. The reference magnitude number has no relationship to the total number of downloads, so how does comparing these two result in what is claimed? The result (relevant or not) is not obtainable by comparing the numbers as claimed. The numbers being compared having nothing to do with each other. Once the reference magnitude is compared to the total number of downloaded products, what next? After the comparison step and based on the result, under what circumstances is the reference magnitude considered relevant? As an example, if the reference magnitude is 3 (the raw number of times a key/value pair was present in the product), and the total number of downloads is 17, is the reference magnitude relevant or not? What if the reference magnitude is 3 and the number of downloads are 3? Is the reference magnitude relevant when the two numbers are equal? What if the number of downloads is zero? There is not enough guidance to enable one of skill in the art to make and use the claimed invention. The examiner feels that one of skill in the art could not even possibly determine the relevancy of the reference magnitude by comparing the reference magnitude to the total number of downloads, because the total number of downloads has nothing to do with whether or not the product that the reference magnitude represents is relevant or not. The examiner does not see how the alleged result of determining relevancy can be achieved by comparing the reference magnitude to the total number of downloads as claimed. Due to the lack of guidance in the specification, one of skill in the art would have to practice undue experimentation to

be able to figure out how to make and use the invention as claimed. The claims are not enabled.

4. Applicant's arguments with respect to claims 1-49 have been considered but are moot in view of the new ground(s) of rejection.

With respect to prior art and the allowability of the claims in view of prior art, the applicant should *not* take the lack of a prior art rejection in the current office action to be an indication of allowability over prior art for the inventive concept as a whole. Applicant is claiming a step that is not enabled by the specification as originally filed (see 112,1st rejection), and prior art is not being applied to the claims due to this limitation being in the claims. The examiner takes the position that comparing the reference magnitude to the total number of downloaded products cannot result in a determination of relevancy as claimed due to the two pieces of data having nothing to do with each other. With respect to obviousness under 35 USC 103, one of ordinary skill in the art would not be motivated to compare two pieces of data that have nothing to do with each other, hence, no prior art is being applied. This does not mean that the invention otherwise is allowable over prior art.

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dennis Ruhl whose telephone number is 571-272-6808. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 571-272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

DENNIS RUHL
PRIMARY EXAMINER